

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

ROVI CORPORATION, ROVI GUIDES, INC. (F/K/A GEMSTAR-TV GUIDE INTERNATIONAL INC.), UNITED VIDEO PROPERTIES, INC., and INDEX SYSTEMS, INC.,

Plaintiffs,

V.

**TOSHIBA CORPORATION, TOSHIBA
AMERICA, INC., TOSHIBA AMERICA
CONSUMER PRODUCTS, L.L.C., and
TOSHIBA AMERICA INFORMATION
SYSTEMS, INC.,**

Defendants.

Civil Action No. 10-931-JBS

JURY TRIAL DEMANDED

MOTION TO STAY PURSUANT TO 28 U.S.C. § 1659

Defendants Toshiba Corporation, Toshiba America, Inc., Toshiba America Consumer Products, L.L.C., and Toshiba America Information Systems, Inc. (collectively, “Defendants”) hereby respectfully move that the Court stay this case pursuant to 28 U.S.C. § 1659.¹

This action was filed on October 29, 2010 alleging infringement of U.S. Patent Nos. 6,020,929 (“the ‘929 patent”), 6,305,016 (“the ‘016 patent”), and 6,701,523 (“the ‘523 patent”). Plaintiffs also filed a Complaint under Section 337 of The Tariff Act of 1930, as Amended, before the U.S. International Trade Commission (“ITC”) and asked the ITC to institute an

¹ By virtue of this motion, none of the Defendants waives, and in fact, each of the Defendants expressly reserves, all defenses and procedural rights otherwise available to it.

investigation under Section 337 against all defendants in this civil action. In their ITC Complaint, Plaintiffs assert infringement of the same '929, '016 and '523 patents at issue here.

On November 24, 2010, the investigation titled *Certain Products Containing Interactive Program Guide and Parental Controls Technology*, Inv. No. 337-TA-747 ("ITC Proceeding") was instituted by publication of a Notice of Institution in the Federal Register. 75 Fed. Reg. 71737; 19 C.F.R. § 210.10(b); *see* Exhibit A (attaching Notice of Investigation). Under Section 1659 of Title 28, upon the request of any party to a civil action that is also a respondent in an ITC investigation involving the parties in the civil action, the Court "shall stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission." 28 U.S.C. § 1659(a). This stay is mandatory and must be granted if it is made within thirty days from the later of: (1) the party being named a respondent in a proceeding before the ITC, or (2) the filing of the district court action. 28 U.S.C. § 1659(a)(1)–(2); *see also In re Princo*, 478 F.3d 1345, 1355 (Fed. Cir. 2007) (granting a writ of mandamus and directing a district court to stay proceedings pursuant to 28 U.S.C. § 1659(a) until the ITC proceeding became final).

The ITC Proceeding involves the Defendants in this civil action. *See* Exhibit A at 71737. Plaintiffs allege infringement of the '929, '016 and '523 patents in both the ITC Proceeding and this parallel civil action. Accordingly, the issues are the same between the ITC Proceeding and this action. On November 24, 2010, the Notice of Institution issued by the ITC was published in the Federal Register, thus commencing the ITC Proceeding. *See* Exhibit A at 71737. Thus, this motion has been filed within thirty days of Defendants being named as respondents in an ITC proceeding.

For the foregoing reasons, Defendants respectfully request that the Court stay this action under 28 U.S.C. § 1659(a). A proposed Order granting this Motion is submitted herewith for the Court's convenience.

ASHBY & GEDDES

/s/ Tiffany Geyer Lydon

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Attorneys for Defendants

Dated: December 13, 2010

CERTIFICATION PURSUANT TO LOCAL RULE 7.1.1.

I hereby certify that counsel for Defendants made a reasonable effort to reach agreement on the attached motion with counsel for Plaintiffs, but Plaintiffs had not responded as of the time of the filing of this motion.

/s/ Tiffany Geyer Lydon

Tiffany Geyer Lydon

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**ORDER STAYING ACTION
PURSUANT TO 28 U.S.C. § 1659**

This _____ day of _____, 2010, the Court having considered Defendants' Motion to Stay Pursuant to 28 U.S.C. § 1659, and having concluded that good grounds exist for the requested relief; now therefore,

IT IS HEREBY ORDERED that the foregoing motion is granted, and that all proceedings in this action are stayed pending final determination of the United States International Trade Commission in the investigation titled *Certain Products Containing Interactive Program Guide and Parental Controls Technology*, Inv. No. 337-TA-747.

The Honorable Jerome B. Simandle
United States District Judge